

REMARKS

I. Status of Claims

Claims 1-42 are pending in the application. No amendments are made by this Response.

II. Rejection under 35 U.S.C. § 103

(1) Cotteret in view of Mockli and (2) Kao Corp. in view of Mockli

Claims 1-42 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,735,908 to Cotteret et al. ("Cotteret") in view of WO 95/01772 to Mockli ("Mockli") and claims 1-23, 32-36, and 41-42 stand rejected as unpatentable over DE 295 12 302 to Kao Corp. ("Kao") in view of Mockli. Office Action at pages 2 and 4. In response to Applicant's arguments demonstrating a lack of motivation to combine the cited references, as supported by the declaration of Mme. Rondeau, the Office argues that the comparison testing carried out between the inventive composition and compositions representative of Cotteret and Kao was not commensurate in scope with the present claims. *Id.* at page 7. According to the Office, a more direct comparison with the compositions of the references is required. *Id.* at page 8. Applicant continues to disagree for the reasons of record and for the additional reasons provided below.

As an initial matter, comparative testing "must be sufficient to permit a conclusion respecting the relative effectiveness of applicant's claimed compounds and the compounds of the closest prior art," and must "provide an adequate basis to support a legal conclusion of unobviousness." *In re Geiger*, 815 F.2d 686, 689, 2 U.S.P.Q.2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring). Applicant, however, is not

required to compare the claimed invention with subject matter that does not exist in the prior art. *Id.*, 2 U.S.P.Q.2d at 1279. Moreover, “the applicant is not required to create prior art, nor prove that his invention would have been obvious if the prior art were different than it actually was.” *Id.*, 2 U.S.P.Q. at 1279.

In addition, according to the Court of Customs and Patent Appeals in *In re Chapman*, requiring an applicant to compare the claimed invention with a polymer suggested by the combination of references relied upon in the rejection under 35 U.S.C. § 103 “would amount to requiring comparison of the results of the invention with the results of the invention.” 357 F.2d 418, 422, 148 U.S.P.Q. 711, 714 (C.C.P.A. 1966). This is not required for comparative testing. *Id.*, 148 U.S.P.Q. at 714. As such, the submitted declaration of Mme. Rondeau sufficiently compares dye compositions *representative of* Cotteret and Kao Corp., i.e., the primary references, with the inventive composition demonstrating at least the relative effectiveness of the claimed compounds.

Kao's Compositions

According to the Office, Kao teaches compositions for dyeing or toning human hair, which comprise a direct dye and a hydroxyalkyl guar gum or a quaternary salt thereof. Office Action at page 4, lines 5-7. As such, composition A in the declaration included Basic Orange 31 (a cationic direct dye), Jaguar C136 (a quaternized hydroxypropyl guar gum), dodecylpolyglucoside, amino 2 methyl propanol 1, and water. Thus, all the required elements of Kao's disclosure were included in the dye composition examined in the comparison.

The Office, however, takes issue with the absence of a conditioning polymer. Office Action at page 7. As argued by the Office, “Kao was relied upon to teach the

addition of cationic conditioning polymers to hair dyeing composition containing basic (cationic) dyes,” but “[a]pplicant does not compare a composition within the scope of Kao containing either dimethyldiallyl ammonium chloride or cationic vinylpyrrolidone polymers and a basic dye.” *Id.* Applicant disagrees. To require Applicant to include any hair conditioning polymer would be one thing, but to insist that Applicant compare a composition having specific polymers identified by the Office, i.e., dimethyldiallyl ammonium chloride and cationic vinylpyrrolidone, is unreasonable.

For example, it is only on page 3 that Kao mentions the optional inclusion of “at least one synthetic or natural hair-conditioning polymer.” According to this disclosure, “basically *all* types of polymers can be used: non-ionic, ionic, amphoteric and cationic polymers, cationic polymers are preferred within the framework of the invention.” Kao at page 3 (emphasis added). Given this disclosure, it is unclear how the Office concludes that a cellulose derivative (dimethyldiallyl ammonium chloride) must be included in the comparative dye composition.

In addition, the Office singles out for inclusion “cationic vinylpyrrolidone” polymer. Office Action at page 7. Despite cationic polymers being “preferred,” there is nothing in Kao directing a skilled artisan to the requirement of vinyl pyrrolidone polymers as the cationic polymers; it is only the present specification that provides this guidance and using the specification as a template is impermissible hindsight.

Moreover, if the Office is going to require the inclusion of hair conditioning polymers, then the other optional additives must equally be included, i.e., surfactants, alcohols, emulsifiers, pH regulators, solvents and binders, solubilizers, preservatives, perfumes, etc. because these ingredients are also equally taught in Kao’s disclosure.

This leads to not only an unlimited number of dye compositions but also unlimited number of possible combinations for testing. But from Kao's disclosure and claims, the dye composition clearly must include at least one direct dye and at least one hydroxy C2-C4 alkyl guar gum or its quaternary salt. Kao at page 1. Composition A includes those ingredients and thus, is representative of Kao's disclosure.

Cotteret's Compositions

Likewise, Cotteret teaches using cationic or amphoteric substantive polymers to oxidation dye compositions and broadly discloses the addition of direct dyes to the dye compositions. Office Action at page 2, lines 4-7, 10-12. As such, Composition B in the comparison included HC Yellow 7 (a neutral direct dye), polyquaternary ammonium (a cationic or amphoteric substantive polymer), dodecylpolyglucoside, amino 2 methyl propanol 1, and water. Thus, Composition B is representative of Cotteret's teachings.

According to the Office, one exemplification of the claimed composition will not overcome the rejection. Office Action at page 8. As held by the Federal Circuit in *In re Chupp*, however, "[e]vidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a prima facie case of obviousness." 316 F.2d 643, 646, 2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987) (citing *In re Ackermann*, 444 F.2d 1172, 1176, 170 U.S.P.Q. 340, 343 (C.C.P.A. 1971)). In fact, the court pointed out that an "undue breadth" rejection couched in Section 103 language is misplaced. *Id.*, 2 U.S.P.Q.2d at 1439. Moreover, there is no set number of examples necessary. *Id.*, 2 U.S.P.Q.2d at 1439.

In this case, according to Mme. Rondeau's declaration, the inventive composition exhibited a significant decrease in color variation, as measured by ΔE . As discussed in

the present specification, color variation, i.e., color selectivity, is "the homogeneity of the color distributed along the fiber ("unison") where the coloration is said to be too selective" Specification at page 2, ll. 9-14. As such, the comparison demonstrates that at least with regard to color selectivity, the inventive composition gives colorations that are less selective, i.e., form an even distribution along the fiber, than dye compositions falling within the disclosures of Cotteret and Kao (compositions A and B), which suggest color variations. See Declaration of Mme. Rondeau. These results coupled with the lack of a motivation to combine Cotteret with Mockli and Kao with Mockli demonstrate that a prima facie case of obviousness has not been established and thus, Applicant respectfully requests the withdrawal of the rejection.

II. Conclusion

In view of the foregoing remarks, Applicant submits that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Response, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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